REMARKS

In an Office Action mailed April 19, 2007, the Examiner objected to claims 38 and 49, and rejected claims 37-42 and 48-52 under 35 U.S.C. § 102(e) over Oliver (U.S. Patent No. 6,480,885). Applicant herein amends claims 38, 48, and 49. As a result, claims 37-42 and 48-52 are pending.

Applicants would like to thank the Examiner for her consideration during the telephone interview of June 5, 2007. During the interview, the Examiner and applicants' representative discussed the Oliver reference and applicants' proposed amendment and remarks. In particular, applicant's representative explained that applicants' claims recite a first device that both sends and receives a translation preference during an established instant messaging session. As discussed during the interview, this exchange of translation preferences would typically be performed without the users' knowledge and before the first instant messages are exchanged between the users. For reasons discussed in detail below, applicants submit that the pending claims are now in condition for allowance.

A.   Claim Objections

The Examiner objected to claims 38 and 49 based on a typographical error. Applicant has amended claims 38 and 49 to correct this error.

B.   Rejections Under 35 U.S.C. § 102(e)

The Examiner rejected claims 37-42 and 48-52 under 35 U.S.C. § 102(e) over Oliver.

1.   Oliver

Oliver describes a technique for filtering subscribers of a mailing list into personalized subsets of the mailing list. (3:8-32.) When a user sends an email to a mailing list, Oliver describes that a server receives the email and determines which subscribers within the mailing list are to receive the email, by comparing the user's profile

data against the acceptance criteria of each subscriber. (*Id.*) A user's profile includes both a base user profile (e.g., name, address, email address, age, occupation) and a subscription user profile that contains information specific to the particular mailing list. (7:29-38.) As part of the subscription process, a subscriber specifies acceptance criteria data that may be specific to a mailing list. The subscribers' acceptance criteria data is used to control with whom and about what topics the subscribers interact. (5:24-26 and 7:15-38.) For example, a user may subscribe to a financial investment mailing list specifying that he only wishes to receive email about international mutual funds from other men of age 40-50 within 3 miles of his office. (10:43-59.) Also, as part of the subscription process, a subscriber may specify a language preference for translation between languages within a mailing list. (17:28-39.) Oliver explains that "[a]t email distribution time, the email server uses an external language translation process to determine the message's language, [and] [f]or each user whose language preference doesn't match that language, the message is translated before being sent." (*Id.*)

Oliver explains that only subscribers of a mailing list may send email to the mailing list. (9:18-46, 10:28-41, and 13:43-54.) However, a user may subscribe to a mailing list at the time the user sends a first email to the mailing list, by sending user profile data with the first email. (*Id.*) The user's subscription may be transient (i.e., associated with a single email) or stored in a database. (*Id.*) Oliver explains that replies to a transient subscriber's email back to the mailing list will reach the transient subscriber, but other messages to the mailing list will not. (*Id.*)

2.   Applicants' technology

Applicants' technology translates instant messages exchanged between a first user using a first device and a second user using a second device. For example, as illustrated in Figures 5A and 5B of applicants' specification, applicants' technology translates instant messages exchanged between a user of device 200 having a first translation preference 214 (e.g., Swahili) and a user of device 202 having a second language preference 216

(e.g., English). During an established instant messaging session, device 200 sends an indication of first translation preference 214 to device 202 and receives from device 202 an indication of second translation preference 216. When the user of device 200 composes a message, device 200 translates the message from first translation preference 214 to second translation preference 216 and transmits the translated message to device 202. Because device 200 translates the message before transmitting it to device 202, the second user receives the message in second translation preference 216.

Claims 37-42 recite "sending by the first device to the second device during the established session an indication of the first translation preference [and] receiving by the first device from the second device during the established session an indication of the second translation preference." As amended, claims 48-52 recite "a component that during the established instant messaging session transmits to the second device an indication of the first translation preference [and] a component that during the established instant messaging session receives from the second device an indication of the second translation preference." Thus, the claims recite that a first device both sends and receives a translation preference. Oliver describes nothing similar to applicant's claimed approach.

3.   Analysis

The Examiner relies on Oliver's discussion at 13:43-54 and 17:21-39 to reject the claims. In these sections, Oliver describes that when a sender is not a subscriber of a mailing list, the sender must include the sender's profile data in messages sent to the mailing list (13:43-54), and that a user may specify a language preference during the subscription process (17:21-39). Although a sender's profile data may be included in a message to a mailing list, Oliver does not teach or suggest that the sender "receives...from the second device during the established [instant messaging] session an indication of [a] second translation preference" as recited by all the claims.
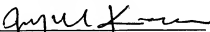
Because a user may specify a language preference during the subscription process, the Examiner appears to suggest that the server or a transient user's computing device correspond to the recited "first device." Applicant respectfully disagrees. Oliver's server cannot correspond to the recited first device that "send[s]...to the second device during the established session an indication of the first translation preference" because the server does not send a translation preference to any device. Rather, the server receives a language preference from a transient subscriber. Oliver's transient user's computing device also cannot correspond to the recited first device that "send[s]...to the second device during the established session an indication of the first translation preference." The transient user's computing device sends a translation preference, but does not receive a language preference. As such, Oliver has nothing that identically corresponds to the recited first device.

C. Conclusion

Based upon the above amendments and remarks, applicant respectfully requests reconsideration of this application and its early allowance. If the Examiner has any questions, or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 359-8548.

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